

## REMARKS

According to the Office Action, claims 1-19 and 113-120 stand withdrawn.

Claims 25, 36, 58, 62, 70, 72, 80, 95, 100 have been amended. Claims 106, 108, and 110-112 have been cancelled.

Additionally, new claim 121 has been added. New claim 121 is like old claim 88 including the limitations of the intervening claims and has been indicated by the office action that it is allowable.

### **Rejections under 35 § U.S.C. 112.**

According to the Office Action, claims 25, 36, 72, and 112 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended each of these claims and submits that they now comply with 35 U.S.C. § 112, second paragraph. Withdrawal of the rejections is requested.

### **Rejections under 35 § U.S.C. 102.**

According to the Office Action, claims 58, 62, 63, 66, 68, 69, 80, 82-87, 89, 93, 94, 100, 101, and 104-107 stand rejected under 35 U.S.C. § 102(b), as being clearly anticipated by Austin et al. (5,702,390).

Applicants respectfully request reconsideration in view of the amendments shown above and the comments below.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 *citing* Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Amended claims 58, 62, and ~~88~~<sup>80</sup> recite that the probe is adapted to provide electrically conductive fluid around the active electrode sufficient to form a plasma when a sufficient voltage difference is provided between the active electrode and the return electrode.

The Austin patent does not teach this limitation.

Regarding independent claim 100, it has been amended to include the claim limitations of claim 108, which the Office Action indicated was an allowable claim if

rewritten in independent form including all the limitations of the base claim and any intervening claims.

The other claims that stand rejected based on Austin depend from one of the claims discussed above and consequently are patentable over Austin for the same reasons that the above discussed claims are patentable over Austin.

Based on the foregoing, withdrawal of the rejections as being anticipated by the Austin patent is requested.

According to the Office Action, claims 20-22, 24, 37-40, 51, 70, 74, 75, 78, 80-86, 94, 95, 100, 101, 104, 105, 110, and 112 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Knoepfler (5,217,460).

Regarding claim 20 and the claims depending therefrom, Knoepfler does not show a return electrode as a conduit, being one in the same as claimed by Applicants. Consequently, Knoepfler does not anticipate claims 20-22, 24, 37-40, 51, 70, 74, 75, 78, and 95.

Regarding claims 80-86, 94, 100, 101, 104, 105, Knoepfler does not show an active electrode disposed on the inferior surface of the electrode support. The Knoepfler patent does not teach or suggest an electrode support much less attaching an active electrode to its inferior surface.

The Knoepfler patent also fails to describe providing an electrically conductive fluid around the active electrode sufficient to form a plasma as recited in amended claim 80.

Regarding claims 100, 101, 104 and 105, these claims include the claim limitation of claim 108 which the Office Action had indicated would be allowable if rewritten in independent form. Consequently, each of these claims is believed to now be allowable.

Regarding claims 110-112, these claims have been cancelled.

Based on the foregoing, reconsideration and withdrawal of the rejections based on Knoepfler are requested.

According to the Office Action, claims 20-22, 24, 26, 37-40, 51-56, 70, 73-75, 78, 80-82, 85, 86, 89, 94-97, 99-102, 104, 105, 110-112 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Mulier et al (6,096,037).

Each of the claims includes a claim limitation that is not shown or suggested in Mulier. In particular, the claims require that the active electrode support may articulate with respect to the shaft and that the return electrode is fixed to the shaft or an extension. In other words, the claimed invention provides articulating movement for the active electrode to manipulate the tissue while the return electrode is fixed.

In contrast, Mulier provides a forceps device that has two operating jaws each of which must be moved in order to open and close the device. For this reason, Mulier does not teach or suggest each of the claim limitations found in the above listed claims. Withdrawal of the rejection is respectfully requested.

With respect to claim 100 and the claims depending therefrom, these claims include the claim limitation of claim 108 which the Office Action had indicated would be allowable if rewritten in independent form. Consequently, each of these claims is believed to be allowable.

Regarding claims 110-112, the rejections are moot as these claims have been cancelled by this amendment.

According to the Office Action, claims 58, 62, 63, 66, 68, 69, 80, 82-87, 89, 93, 94, 100, 101, 104-107, and 110 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Yamauchi et al (6,273,887).

Regarding claims 58, 62, 63, 66, 68, 69, 80, 82-87, 89, 93, and 94 these claims are patentable over Yamauchi because Yamauchi lacks the claim limitation that the probe is adapted to provide an electrically conductive fluid to the active electrode sufficient to create a plasma when a proper voltage difference is applied between the active and return electrode. This claim limitation is not taught or suggested in Yamauchi. Accordingly, withdrawal of the rejections is requested.

With respect to claim 100 and the claims depending therefrom, these claims include the claim limitation of claim 108 which the Office Action had indicated would be allowable if rewritten in independent form. Consequently, each of these claims is believed to be allowable.

Regarding claim 110, it has been cancelled. The rejection is now moot.

Based on the foregoing, reconsideration and withdrawal of all rejections based on Section 102 are respectfully requested.

**Rejections under 35 § U.S.C. 103.**

According to the Office Action, claim 64 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Austin or Yamauchi.

Applicants submit this claim is patentable over either of the above references for the reasons that independent claim 62 is patentable over the references as discussed above in connection with the Section 102 rejections.

Based on the foregoing, Applicants respectfully request reconsideration and allowance of the pending claim 64.

**IN CLOSING**

Applicants believe they have responded to all issues raised in the outstanding office action. If the Examiner believes a telephone conference would expedite prosecution of this application, a telephone call to the undersigned attorney at the below listed number will be appreciated.

Respectfully submitted,



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12/5/03  
Date

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